

REMARKS

Without acquiescing to the propriety of the rejections in the Office Action dated September 21, 2006, claims 1, 9 and 10 have been amended, and new claims 11-20 have been added. Entry of these amendments, reconsideration of the application, and allowance of all claims pending herein are respectfully requested in view of the remarks below. Claims 1-20 are now pending.

§ 112 Rejections:

Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action objects to the phrase “said varnish layer being a non-ink layer” because this negative limitation is alleged not to be supported by the specification. The Office Action also objects to “said adhesive layer remaining repositionable when cured” as lacking support in the specification. The subject matter of the objected to claims have been removed from claim 1 and are present in new dependent claims 11 and 12. Applicant respectfully disagrees with the Examiner’s arguments.

Relative to the varnish layer being a “non-ink” layer, one skilled in the art would understand from page 8 of the specification that the varnish layer is a non-ink layer when deposited onto one of the impregnation layers. The fourth paragraph on page 8 describes the varnish layer as being selected for its good printing properties, along with various inks for printing on the varnish layer being described. It would be evident to one skilled in the art that the varnish layer is non-ink and non-printed when deposited onto the one of the impregnation layers and prior to an ink layer being deposited onto such varnish layer. More specifically, there would be no reason to select a varnish for its good printing capacities (as described on page 8) if it was already printed or already had ink applied thereto. Thus, support for the “non-ink” layer is found in the specification and this rejection is believed to be overcome.

Relative to the adhesive layer remaining repositionable when cured, page 3 of the specification makes clear that the adhesive is selected to allow a user to detach a support from a display zone such that it may be repositioned as many times as is necessary to allow such repositionability. Thus, the repositionable adhesive must be repositionable both before and after being cured since it may be repositioned as many times as is necessary. Accordingly, support for

the “repositionable when cured” language is found in the specification and this rejection is believed to be overcome.

Claim 1 has also been amended to recite, *inter alia*, that the repositionable pressure sensitive adhesive layer remains continuously repositionable. The added language would be understood by one who is skilled in the art as being supported by the specification given the description of the adhesive allowing the display support to be repositioned as many times as is necessary. Thus, claim 1 satisfies § 112.

Response to Arguments:

In the Response to Arguments Section of the most recent Office Action, the Examiner alleges that Crouch’s varnish layer is not “printable” nor is there “an ink layer deposited thereon”. Particularly, the Examiner argues that Crouch specifically discloses printing at column 2, lines 20-22 and that the ink layer includes pigments and varnishes that is described in column 3, lines 24-26.

Applicant respectfully disagrees with this logic. In particular, column 2, lines 20-22 of Crouch, et al. discloses ink that is dried using warm air on a release paper. However, there is no disclosure of an ink layer deposited on a varnish layer nor any other “printing” as alleged. Instead, these lines disclose ink being deposited such that a portion thereof may be removed to form letters as described below. Further, column 3, lines 24-26 disclose ink which includes components, one of which is varnish. The ink layer is eradicable as described in the first paragraph of column 3 and lines 40-44 of column 4. Finally, there is a no disclosure in Crouch et al. of an ink layer which is deposited on a varnish layer. The ink layer and varnish layer are the same layer if the ink includes varnish as described in the third paragraph of column 3.

Claim Rejections Under 35 U.S.C. § 103:

Claims 9-10 stand rejected under 35 U.S.C. § 103(a) as being obvious over Gray et al. (U.S. Patent No. 5,707,904) in view of Crouch et al. (U.S. Patent No. 5,895,705) and Paquette et al. (U.S. Patent No. 5,229,207). In particular, Gray et al. is alleged to disclose all the elements of the claimed invention except for a teaching of a laminate comprising a varnish layer and a repositionable pressure sensitive adhesive layer. Crouch et al. is alleged to disclose a varnish

layer and Paquette et al. is alleged to disclose a layer of adhesive which is pressure sensitive and affords good repositionability. The Office Action alleges that it would have been obvious to one of ordinary skill in the art to incorporate Crouch's varnish layer in the laminate of Gray et al. and Paquette et al. It is also alleged that it would have been obvious to have incorporated Paquette et al.'s repositionable pressure sensitive adhesive in the laminate of Gray et al. and Crouch et al.

Also, relative to claim 10, the Office Action alleges that although Gray et al., Crouch et al., and Paquette et al. do not explicitly teach the claimed adhesive force, it is reasonable to presume that this property is inherent to the inventions of these patents. Also, the Office Action alleges that the claimed range of an adhesive force between 1 and 100 Newtons, for a strip with a width of 5 cm, would obviously have been present once the product disclosed in the patents is provided.

The rejections relative to claim 9 are the same as those in the previous Office Action relative to claims 1-6. Claim 9 is believed to be allowable for the same reasons as described above in the Response to Arguments Section, the arguments in the last response and those discussed below. Further, amended claim 9 recites, *inter alia*, a continuously repositionable pressure-sensitive adhesive layer, a printable varnish layer and an ink layer separate from the varnish layer. The ink layer is deposited on the varnish layer to provide printing to the varnish layer.

Gray et al. discloses a coated awning fabric for use with a backlit sign. The coated fabric includes a textile scrim, and it is desired to minimize the appearance of the scrim from the side of the fabric opposite a light. The scrim is treated with an optical brightener on one side and a translucent coating on the other side. An opaque coating may also be applied to the translucent coating. A solvent may be selectively applied to the opaque coating to form a selected pattern (e.g., a sign) on the awning fabric. The selected pattern comprises opaque regions which may define letters relative to the translucent portions of the fabric when a light is applied to a backside of the fabric.

As described in columns 1-2 of Crouch et al., the Crouch et al. invention is considered by the Crouch et al. applicant to be an improvement to that described in Gray et al. Crouch et al. discloses an awning sign formed by attaching a back-lit sign and awning fabric on top of a pre-

dried ink layer rather than first constructing a white fabric and then applying a wet ink layer on top thereof as is conventionally done, as described in column 2 of this reference. In particular, ink is applied to a release paper (see column 4, lines 13-16) and dried using warm air. A PVC plastisol is cast on to the release paper and a fabric scrim is applied thereto. After drying, a textile fabric is applied to the release paper. After calendaring and cooling, the release paper is stripped from the combined product. As noted above, Crouch et al. is alleged to disclose a varnish layer on a surface of PVC plastisol coating layer that coats a fabric. The alleged varnish layer consists of ink uniformly deposited across at least one surface of the release paper as described in column 4 of this reference. Such a varnish layer consisting of ink is not an ink layer separate from a varnish layer which is deposited on the varnish layer to provide printing to the varnish layer as recited in claim 9. Instead, as described in the third paragraph of column 3 of Crouch et al., the varnish is utilized to form ink which is deposited on the release paper, but the varnish is not separate from the ink layer nor is an ink layer deposited thereon to provide printing thereto as recited in claim 9. Further, there would be no motivation to print on the ink (alleged to be a varnish layer) in Crouch et al. since any lettering would be previously provided by the ink itself applied to the release paper.

Paquette et al. discloses a film having a flexible backing bearing a layer of adhesive which allows good repositionability and can also become permanently bonded to highly plasticized substrates. As described in lines 15-20 and 57-62 of column 2, the film is initially repositionable but then becomes permanently bonded within a short period of time. There is no disclosure in this reference of any fabric structure, a varnish layer allowing printability, or any other features recited in claim 9. The mere existence of this repositionable layer would not make it obvious to combine it with either of the other cited references. Moreover, the layer disclosed is not continuously repositionable as recited in claim 9, and instead becomes permanently bonded within a short period of time.

The Office Action alleges that it would have been obvious to incorporate Crouch et al.'s varnish layer in the laminate of Gray et al. and Paquette et al. However, Gray et al. accomplishes the goal of creating letters or other information through applying an opaque coating onto a translucent coating and selectively applying solvent to the opaque coating to form a selected pattern on an awning fabric. Thus, there is no need when utilizing the invention of Gray et al. to

print on the awning. Accordingly, there would be no reason to utilize a printable varnish layer in the Gray et al. awning, as recited in claim 9 of the present application, because the objective of the printing (e.g., lettering for a sign) is accomplished by other means, i.e., selectively applying solvent to the opaque coating previously applied. Accordingly, even if the alleged varnish layer in Crouch et al. was equivalent to that recited in claim 9, there would be no reason to combine this layer into Gray et al. to arrive at the subject matter recited in claim 9.

Further, the Crouch et al. invention is considered by the Crouch et al. applicant to be an improvement to that described in Gray et al. It could not have been obvious to incorporate the alleged varnish layer from Crouch et al. into Gray et al. since Crouch et al. was considered by the Crouch et al. applicant to be an improvement over the Gray et al. invention disclosure, but such improvement did not incorporate the proposed combination. Thus, because Gray et al. and Crouch et al. accomplish the goal of providing lettering to an awning fabric or sign differently, the references themselves teach away from the proposed combination, and there would be no reason to incorporate the alleged varnish layer of Crouch et al. into an earlier version of such an awning fabric, i.e., the device disclosed in Gray et al.

Relative to the allegation that it would have been obvious to incorporate Crouch et al.'s varnish layer in the laminate of Gray et al. and Paquette et al. due to a desire to create a laminate that has ease of printing and increased stiffness, Gray et al. does not have a need for a layer with such alleged desired ease of printing nor does Paquette et al. disclose any reason for a layer having an ease of printing. Further, Crouch et al. discloses ink having a varnish and does not disclose a layer configured to be printed particularly since the ink disclosed therein has already been applied to the release paper and transferred to the plastisol layer. There would be no reason for further printing of the fabric disclosed therein. The alleged motivation of increased stiffness is unclear.

Further, there would also be no reason to incorporate a repositionable pressure sensitive adhesive as allegedly disclosed in Paquette et al. into the awning described in Gray et al. As described in this reference, the awning is attached to a frame and is backlit by an illumination source. There would be no reason to reposition any portion of the awning and instead it is desired for the awning to remain in one location. The scrim as described in Gray et al. and Crouch et al. is utilized to reinforce the awning to provide sufficient strength, durability, and

integrity. The problem which Crouch et al. and Gray et al. attempt to solve is how to have such a durable awning utilizing a scrim while still allowing light to pass therethrough such that the opaque portions (e.g., letters) described above relative to Gray et al., may be viewed by an observer as conveying certain information (i.e., a sign). There would be no desire for any portion of the awning to be repositionable. It is unclear what is meant in the Office Action by a desire to create laminate that has ease of handling and maneuverability. Accordingly, there would be no reason to incorporate Paquette et al.'s allegedly repositionable pressure sensitive adhesive into the disclosures of Gray et al. or Crouch et al.

Thus, because there would be no reason to combine the references, and even if they were combined they would not disclose, teach or suggest all the features (e.g., an ink layer separate from a varnish layer, an ink layer deposited on the varnish layer to provide printing to the varnish layer, and a continuously repositionable pressure-sensitive adhesive layer) of claim 9 of the present application, this claim cannot be obvious over the proposed combination of Gray et al., Crouch et al., and Paquette et al. Therefore, claim 9 is believed to be allowable and the dependent claims are believed to be allowable for the same reasons as claim 9 and for their own individual features.

Claim 10 discloses, *inter alia*, a printable varnish layer and a pressure-sensitive repositionable adhesive layer which possess an adhesive force between 1 and 100 Newtons for a strip with a width of about 5 cm. The adhesive layer remains continuously repositionable. As noted above, Paquette et al. discloses a film which is repositionable when first applied but which becomes permanently bonded. Thus, this reference cannot disclose an adhesive layer which remains continuously repositionable nor an adhesive force of such an adhesive layer in the noted range as recited in claim 10.

Applicant respectfully disagrees with the allegation in the Office Action that the claimed adhesive force is inherent or could reasonably be presumed to be inherent in the inventions of the cited patents. As per MPEP § 2112, to establish inherency the evidence must "make clear that the missing descriptive matter is necessarily present in the reference and "may not be established by probabilities or possibilities". Further, an "allegedly inherent characteristic" must "necessarily flow from the teaching of the applied prior art". The mere possibility of an adhesive force in the proposed combination falling within the claimed range is not enough to make this

feature inherent. Moreover, there is no reason that one of ordinary skilled in the art would consider the claimed feature to “necessarily” flow from teaching of the prior art and instead adhesive forces in different ranges, particularly those which would cause permanently bonding, would also be possible. Further, as indicated, the repositionable adhesive layer remains continuously repositionable in contrast to the cited combination of references. Because the claimed adhesive force relates to a continuously repositionable layer which is not disclosed, taught or suggested by the cited references or their combination, and the claimed range would not be inherent from the prior art, claim 10 cannot be obvious over this combination of references.

Further, claim 1 along with the claims depending thereon, are believed to be allowable. In particular, claim 1 is believed to be allowable for at least the reasons described above relative to the continuous repositionability of the pressure-sensitive adhesive layer and the printability of the varnish layer. The dependent claims are allowable for at least these reasons and their own additional features.

New Claims:

Claims 11-20 have been added. Support for these claims is found in the specification, as indicated above, and thus no new matter has been added. Further, these claims are believed to be patentable over the proposed combination of references, and thus are believed to be in condition for allowance.

CONCLUSION

It is believed that the application is in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Examiner is invited to telephone the undersigned attorney at the telephone number provided.

Respectfully submitted,

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